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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/072,042
Filing Date: February 05, 2002
Appellant(s): NYKOLUK ET AL.

Bruce T. Atkins
For Appellant

SECOND EXAMINER'S ANSWER

This is in response to the appeal brief filed 05/13/2008 appealing from the Office action mailed 11/27/2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

It is noted that the appeal of U.S. Application Serial No. 10/875,394 has been decided by the Board. Appellant has filed a Request for Continuing Examination (RCE) awaiting an office action by the examiner.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,508,344	Lu	01-2003
5,908,093	Miyoshi	6-1999
4,368,835	Murphy	1-1983
3,355,075	Dean	11-1967
6,591,951	Chen	7-2003
6,434,790	Chen	8-2002

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

1. Claims 47-50, 52-64, 66-76, and 78-85 are under 35 U.S.C. 103(a) as being unpatentable over Lu (6508344) in view of Miyoshi (5908093). Lu teaches a towing member having an arm comprises the two bars 11 having distal end and proximal end with an axial length, the arm being movable between extended and retracted position (col. 1, ln. 49-50), a towing handle 20, a locking mechanism located proximate the handle movable between a locked position and an unlocked position comprising a movable locking element 521 and a locking channels 421 (see fig. 2 and 4 showing the locking of portion 521 onto the channel 421), and a release mechanism 37 as claimed.

With respect to the non extendable portion, Miyoshi teaches that it is known in the art to provide non extendable portion as shown in Fig. 5, portion 55A. It would have been obvious to one of ordinary skill in the art to provide an extendable portion as taught by Miyoshi to provide a connection to the luggage.

With respect to the limitation wherein axial length of the arm being curved outwardly away from the piece of baggage, the examiner submits that the drawing of Fig. 1 shows a slight curvature of the backpack body and the slight curvature of the two bars 11. The two bars in Lu '344 must be curved to accommodate the backpack with a curved back panel shown in Fig. 1. Furthermore, Miyoshi teaches the two curved arms. Thus, to provide the curved arms as taught by Miyoshi would have been obvious and predictable to enable one to accommodate the back.

With respect to the limitation that the arm being movable between extended and retracted positions relative to the non-extendable portion such that the distal end is a closer distance measured along the center axis of the arm to the piece of baggage when the arm is in the retracted position than when the arm is in the extended position, the examiner submits that similar to that of appellant's invention, due to the outwardly curvature of the two bars, when the bars in the retracted position the distal end where the handle is attached is closer to the baggage than when the arm is in the extended position.

With respect to the distal end of the arm being otherwise unable to move relative to the distal end, the examiner submits that one can have the towing handle pivotable about one axis about the handle as claimed. The functional limitation does not impart any structure over the device in Lu. In other words, one can choose the handle to be stationary in one axis and only rotate in the other axis.

Regarding claim 61, with respect to the limitation that the towing handle fixedly mounted to the distal end along an axis, the examiner submits that the term "fixedly mounted" is broad and does not exclude the handle fixedly locked in several positions as evidence by the locking mechanism of Lu. It is noted that Lu teaches the handle can be fixedly locked in several

positions via the pressing of the button which in turn move the paddle portion 52 in to various lock positions with the channels 721, see figure 1 for the exploded view of the various parts and fig. 6 showing the engagement of portion 52 in the fixed position that claimed.

It is noted that Lu '344 teaches a locking mechanism comprises a movable locking element 521 having a slot (where portion 612 going through) there through and a connector portion 71 mounted stationary to the distal end including a locking post 521 extending through the slot in a direction generally perpendicular to the center axis.

Regarding claim 57, note that there is a face facing outward in Lu (adjacent the distal peripheral edge of portion 35).

Regarding claim 63, note that the tube is curved forward as set forth above.

2. Claims 47-50, 52-64, 66-76, and 78-85 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Lu'344 in view of Miyoshi rejection, as set forth above in paragraph 1, and further in view of either Dean (3355075) or Murphy (4368835).

Even to the degree it is argued that the handle in Lu does not teach the outwardly extending handle, either Dean or Lu teaches that it is known in the art to provide back support structures being curved to accommodate the back. It is noted that Dean teaches a two curved arm portion 20 of the handle. Murphy teaches the

Support members 20 may take a variety of forms and shapes (col. 2, ln. 4)

A back carrier of the type having two substantially parallel tubular support members adapted to be fitted generally vertically to the back of a person, (col. 4, ln. 15-18)

Similarly, Dean teaches curved frames 10 and 12 (See figure 1, and 2) to see the curved frame to fit along the back of the user (col. 4, ln. 63-66). The examiner submits that to provide curved handle in Lu '344 would have been obvious.

Therefore, it would have been obvious to one of ordinary skill in the art to provide outwardly curved handle as taught by either Dean or Lu to enable one to support the handle on the back when wearing.

3. Claims 51, 65, 77, 86, and 87 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lu rejections, as set forth in paragraph 1 and 2, and further in view of either Chen '951 or Chen (6434790). Lu meets all claimed limitations except for the single pole handle. Either Chen '951 or Chen '790 teaches that it is known in the art to provide a single pole handle. It would have been obvious to one of ordinary skill in the art to provide single pole handle as taught by either Chen '951 or Chen '790 to provide an alternative handle.

4. Claims 47-60, and 74-86 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen (6591951) in view of Miyoshi '093, and further in view of either Dean '075 or Lu '344. Chen teaches a towing member having an arm having distal end and proximal end with an axial length, a towing handle 20, a locking mechanism 40 located proximate the handle movable between a locked position and an unlocked position comprising a movable locking element 44 as shown in Fig. 6. Chen meets all claimed limitations except for 1) the non extendable portion and 2) the arm being curved outwardly.

Miyoshi teaches that it is known in the art to provide non extendable portion as shown in Fig. 5, portion 55A. It would have been obvious to one of ordinary skill in the art to provide a non extendable portion as taught by Miyoshi to provide a connection to the luggage.

With respect to the arm being curved, Dean or Lu '344 teaches that it is known in the art to provide back support structures being curved for supporting on the back. As set forth above, Dean teaches curved frames 10 and 12 for supporting on the back of the user (See figure 1, and 2 to see the curved frame to fit along the back of the user, col. 4, ln. 63-66). Lu '344 also teaches the curving of the arm handle as set forth in paragraph 1.

Thus, it would have been obvious to one of ordinary skill in the art to provide outwardly curved handle as taught by either Dean or Lu to enable one to support the handle on the back when wearing.

Furthermore, Miyoshi also provide evidence that it would have been obvious to one of ordinary skill in the art to provide curved telescoping handles. Thus, to provide curved telescoping handles for support on the back would have been obvious as taught by Dean or Lu '344, in view of Miyoshi.

(10) Response to Argument

I. Claims 47-50, 52-64, 66-76, and 78-85 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Lu '344 in view of Miyoshi (5908093).

With respect to the limitation of extendable arms, the examiner submits that Lu teaches the two parallel arm portions (11). Lu is silent in whether there are plural non-extendable sections in each of the two parallel bar portions 11. Appellant asserts that Lu' 344, ln. 48-50 anticipates this limitation (pg. 24, 2nd paragraph). If this is the case, the examiner submits that the rejection of Lu in view of Miyoshi for this limitation is superfluous and need not to be considered from the Board.

Appellant asserts that Lu '344 is appellant's own work. Appellant files two rule 1.132 declarations to establish prior invention.

715.07 [R-3] Facts and Documentary Evidence:

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As discussed above, 37 CFR 1.131(b) provides three ways in which an applicant can establish prior invention of the claimed subject matter. The showing of facts must be sufficient to show

(A) actual reduction to practice of the invention prior to the effective date of the reference; or

(B) conception of the invention prior to the effective date of the reference coupled with due diligence from prior to the reference date to a subsequent (actual) reduction to practice; or

(C) conception of the invention prior to the effective date of the reference coupled with due diligence from prior to the reference date to the filing date of the application (constructive reduction to practice).

A conception of an invention, though evidenced by disclosure, drawings, and even a model, is not a complete invention under the patent laws, and confers no rights on an inventor, and has no effect on a subsequently granted patent to another, UNLESS THE INVENTOR FOLLOWS IT WITH REASONABLE DILIGENCE BY SOME OTHER ACT, such as an actual reduction to practice or filing an application for a patent. *Automatic Weighing Mach. Co. v. Pneumatic Scale Corp.*, 166 F.2d 288, 1909 C.D. 498, 139 O.G. 991 (1st Cir. 1909).

Conception is the mental part of the inventive act, but it must be capable of proof, as by drawings, complete disclosure to another person, etc. In *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897), it was established that conception is more than a mere vague idea of how to solve a problem; the means themselves and their interaction must be comprehended also.

In general, proof of actual reduction to practice requires a showing that the apparatus actually existed and worked for its intended purpose.

Included in the 1.132 are several drawings, however, these drawings fail to show appellants own work. It is noted that the claims directed to a handle with a button operated from a top of the handle, along with various mechanisms, e.g., 242, 246, 220 that necessitate the operation of the handle (see fig. 12). The affidavit requires the showing of conception of the invention and the actual reduction to practice of the invention. In this case, it is noted none of the affidavit shows the locking mechanism that appellant is claiming in this instant application.

The examiner submits that appellant fails to show the conception and the actual reduction to practice of the invention as required by MPEP 715.07. Thus, the 1.132 declaration is ineffective.

Appellant also asserts that *In re Debaun* asserts that there is nowhere require evidence of a reduction to disqualify a reference. The examiner addressed this case in the appeal of U.S.

Application Serial No. 10/875,394. The examiner also submits the following similar arguments:

716.10 Attribution

Under certain circumstances an affidavit or declaration may be submitted which attempts to attribute an activity, a reference or part of a reference to the applicant. If successful, the activity or the reference is no longer applicable. When subject matter, disclosed but not claimed in a patent application filed jointly by S and another, is claimed in a later application filed by S, the joint patent or joint patent application publication is a valid reference available as prior art under 35 U.S.C. 102(a), (e), or (f) unless overcome by affidavit or declaration under 37 CFR 1.131 showing prior invention (see MPEP § 715) or an unequivocal declaration by S under 37 CFR 1.132 that he or she conceived or invented the subject matter disclosed in the patent or published application. Disclaimer by the other patentee or other applicant of the published application should not be required but, if submitted, may be accepted by the examiner.

Where there is a published article identifying the authorship (MPEP § 715.01(e)) or a patent or an application publication identifying the inventorship (MPEP § 715.01(a)) that discloses subject matter being claimed in an application undergoing examination, the designation of authorship or inventorship does not raise a presumption of inventorship with respect to the subject matter disclosed in the article or with respect to the subject matter disclosed but not claimed in the patent or published application so as to justify a rejection under 35 U.S.C. 102(f).

However, it is incumbent upon the inventors named in the application, in response to an inquiry regarding the appropriate inventorship under 35 U.S.C. 102(f) or to rebut a rejection under 35 U.S.C. 102(a) or (e), to provide a satisfactory showing by way of affidavit under 37 CFR 1.132 that the inventorship of the application is correct in that the reference discloses subject matter derived from the applicant rather than invented by the author, patentee, or applicant of the published application notwithstanding the authorship of the article or the inventorship of the patent or published application. *In re Katz*, 687 F.2d 450, 455, 215 USPQ 14, 18 (CCPA 1982) (inquiry is appropriate to clarify any ambiguity created by an article regarding inventorship and it is then incumbent upon the applicant to provide "a satisfactory showing that would lead to a reasonable conclusion that [applicant] is the ... inventor" of the subject matter disclosed in the article and claimed in the application).

An uncontradicted "unequivocal statement" from the applicant regarding the subject matter disclosed in an article, patent, or published application will be accepted as establishing inventorship. *In re DeBaun*, 687 F.2d 459, 463, 214 USPQ 933, 936 (CCPA 1982). However, a statement by the applicants regarding their inventorship in view of an article, patent, or published application may not be sufficient where there is evidence to the contrary. *Ex parte Kroger*, 218 USPQ 370

(Bd. App. 1982) (a rejection under 35 U.S.C. 102(f) was affirmed notwithstanding declarations by the alleged actual inventors as to their inventorship in view of a nonapplicant author submitting a letter declaring the author's inventorship); *In re Carreira*, 532 F.2d 1356, 189 USPQ 461 (CCPA 1976) (disclaiming declarations from patentees were directed at the generic invention and not at the claimed species, hence no need to consider derivation of the subject matter).

(1) *In re Debaun* is not applicable in this case, *In re Debaun* in which a rejection was for obviousness under 35 USC 103 in view of a disclosure already issued to appellant. In this case, the Lu reference does not have attribution to appellant in this instant application. (2) Furthermore, the examiner submits that there is evidence to the contrary that appellant is the inventor of the subjected matter, *Ex parte Kroger*, 218 USPQ 370 (Bd. App. 1982). In this case, appellant was not named as the inventor in 'Lu' is evident that appellant was not the inventor of the invention and that is contrary to appellant's assertion, (3) Even if the Board maintains that *In re Debaun* is relevant in this case, the Examiner submits that although *In re Debaun* does not require evidence of diligence, the affidavits in this case fail even to provide the evidence of conception.

Appellant asserts that the Lu '344 reference fails to teach the handle being fixedly mounted along an axis perpendicular to the center axis of the bars. The examiner submits that "fixedly mounted" is broad and does not exclude the handle that can be fixedly locked in several positions as evidence by the locking mechanism of Lu. It is noted that Lu teaches the handle can be fixedly locked in several positions via the pressing of the button which in turn move the paddle portion 52 in to various lock positions with the channels 421, see figure 1 for the exploded view of the various parts and fig. 4 showing the engagement of portion 52 in the fixed position as claimed.

Appellant asserts that Lu'344 fails to show the curvature of the arms. The examiner submits that the drawing of Fig. 1 shows a slight curvature of the backpack body and the slight curvature of the two arms 11. To provide the two straight arms 11 would not be possible since the straight arm would NOT be able to accommodate for a backpack with a curved back panel shown in Fig. 1. The examiner submits Lu '344 meets the claimed limitation.

Appellant also asserts that to curve the arms as taught by Miyoshi would not be possible since the Miyoshi teach the curving of the handle to the middle of the luggage. The examiner submits that Lu '344 teaches a curved back and to provide curved handle to accommodate the curved back panel would have been obvious since to provide a straight handle in Lu' 344 would not be possible. Miyoshi provides added evidence that to provide a curved telescoping handle is predictable and within the skill of one of ordinary skill in the art.

II. Claims 47-50, 52-64, 66-76, and 78-85 stand rejected under 35 U.S.C. 103(a) as being unpatentable over the Lu'344 rejection, as set forth above, and further in view of either Dean (3355075) or Murphy (4368835).

With respect to the rejection of Lu '344 in view of either Dean or Murphy, the examiner submits that to provide a curved handle as taught by either Dean or Murphy would have been obvious.

As set forth above, Murphy teaches two curved arms forming a handle at portion 20 of the handle. Murphy teaches the

Support members 20 may take a variety of forms and shapes (col. 2, ln. 4)

A back carrier of the type having two substantially parallel tubular

support members adapted to be fitted generally vertically to the back
of a
person, (col. 4, ln. 15-18)

Similarly, Dean teaches curved frames 10 and 12 (See figure 1, and 2) to see the curved frame to fit along the back of the user (col. 4, ln. 63-66). The examiner submits that to provide curved handle in Lu '344 would have been obvious.

III. Claims 51, 65, 77, 86, and 87 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Lu in view of Miyoshi, as set forth in paragraph 1, and further in view of either Chen '951 or Chen (6434790).

The examiner submits that to provide a single pole handle as taught by Chen '951 or Chen '790 would have been obvious since it is well known in the art to substitute one handle for another type of handle.

IV. Claims 47-60, and 74-86 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Chen (6591951) in view of Miyoshi, and further in view of either Dean or Lu '344.

With respect to the Chen '951 in view of Miyoshi, and further in view of either Dean or Lu '344, the examiner submits the following principle of law under KSR Int'l Co. v. Teleflex Inc. In KSR, the Supreme Court cautioned the granting of patents based on the combination of elements found in the prior art. The Supreme Court wrote that:

When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can

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implement a predictable variation, § 103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.

The examiner submits that Dean and Lu '344, each teaches the curving of the handle to accommodate the back as set forth above. The examiner submits that the combinations as set forth above are clear cases of prima facie. The examiner submits that the motivation is to have the structure to conform to the back of the user as taught by Dean or Lu. Furthermore, Miyoshi provides clear evidence that to provide telescoping handle is predictable and within the skill of one of ordinary skill in the art. The examiner submits that the device as claimed is one of predictable variations and § 103 bars its patentability.

(11) Related Proceeding(s) Appendix

Copies of the court or Board decision identified in the Related Appeals and Interferences section of this examiner's answer are provided herein.

Appendix I: The Board decision of U.S. Application Serial No. 10/875,394

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Tri M Mai/

Primary Examiner, Art Unit 3781

Conferees:

/Nathan J. Newhouse/

Art Unit: 3781

Supervisory Patent Examiner, Art Unit 3782

/Anthony D Stashick/

Anthony D Stashick

Supervisory Patent Examiner, Art Unit 3781